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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,505	06/04/2001	Hongjie Cao	1928.PC	4692

7590

08/29/2003

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/873,505

Applicant(s)

CAO ET AL.

Examiner

Gina C. Yu

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 26-48.

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

8/28/05

No. 2: The proposed amendment will not be entered because the new limitation "and the formulation is surfactant-free" would be introduced in the claims for the first time and require further search and consideration.

No. 5: Applicants' arguments with respect to examiner's rejections in final rejection dated May 20, 2003, have been considered, but are unpersuasive.

Applicants argue that no motivation exists to encapsulate sunscreen actives in wax to modify and encapsulate in applicants' starch encapsulation, allegedly because Eskins fails to recognize the benefits of encapsulating known irritants, and Macauley teaches wax encapsulation which gives an oily feel and leaves a residue.

Examiner finds the argument not persuasive. Applicants' broadest claim recites "hydrophobic sun-screen actives", and not necessarily irritants. Examiner disagrees with applicants' argument that the Eskins invention is limited to encapsulating skin penetrating active agents. The reference clearly teaches the applicability of the invention in cosmetics include those products whose active ingredients to be encapsulated can be effective without penetration, such as suntan agents in suntan lotions, or pigments or dyes in lipsticks or eye shadows. Thus, applicants' argument that a skilled artisan would find the Eskins reference only applicable to skin-penetrating personal care products is unpersuasive.

Furthermore, applicants' argument that the drawbacks in Macauley provides no motivation to combine with Eskin reference is unpersuasive. Eskin clearly teaches that the prior art oil-starch encapsulation provides nongreasy yet slippery to the touch. The

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motivation to combine the teachings is found in the collective teachings of both Eskin and Macualet references.

Examiner maintains the position that applicants' arguments are not commensurate with the scope of claim 46. As indicated in the final rejection dated May 20, 2003, claim 46 is directed to a method of making and topically applying personal care or cosmetic products and not specifically to a sun-screen composition.

Applicants assert that no motivation to select cationic surfactants from the Van Soest reference exist allegedly because the reference teaches exhaustive list of other possible types of starch. Examiner maintains the position that the disclosure of only few alternatives does not amount to a "laundry list" nor does the teaching negate the fact that cationic starch is old and well-known in cosmetic art.

Regarding applicants' arguments against the Fletcher and Ashley references, examiner views that each argument is made against references individually rather than in view of the collective teachings of the all cited in the rejection. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, while each of the Fletcher and Ashley references fails to teach a starch-encapsulated hydrophobic compound or aqueous composition, these limitations are taught in Eskins.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner